

Serial No. 10/634,992
Attorney Docket No. 103864.139US1

REMARKS/ARGUMENTS

In the Office Action, the Examiner noted that Group 1A (Claims 1-23 and 30-51) was elected without traverse during a telephone conversation with Irah Donner, Attorney for Applicants, on 5/4/2006. Applicants affirm the election of claims 1-23 and 30-51. Claims 24-29 and 52-57 are withdrawn from further consideration by the Examiner without traverse. The Examiner noted that claim 20 should depend on claim 19. Respectfully, the Applicants have amended claim 20 to depend on claim 19. Further, Applicants have submitted new claims 72-92.

The Examiner rejected claims 1-3, 7-8, 10-16, 19-20, 30-32, 34, 37-39, 43, and 45-49 under 35 U.S.C. 102(e) as being anticipated by Browning U.S. Patent 6,715,266 (hereinafter "Browning"). The Examiner rejected claims 4-6, 33, and 44 under 35 U.S.C. 103(a) as being unpatentable over Browning in view of McGrath et al. U.S. Patent 6,494,017 (hereinafter "McGrath"). The Examiner rejected claim 9 under 35 U.S.C. 103(a) as being unpatentable over Browning in view of Blaimschein U.S. Patent 5,318,420 (hereinafter "Blaimschein"). The Examiner rejected 17-18, 35, and 50 under 35 U.S.C. 103(a) as being unpatentable over Browning in view of Kitamura et al. U.S. Patent 5,423,216 (hereinafter "Kitamura"). The Examiner rejected claims 21-23, 36, and 51 under 35 U.S.C. 103(a) as being unpatentable over Browning in view of Yuyama et al. U.S. Patent 6,644,504 (hereinafter "Yuyama"). The Examiner rejected claims 40-42 under 35 U.S.C. 103(a) as being unpatentable over Browning in view of Coughlin U.S. Patent Application 2004/0059463 (hereinafter "Coughlin").

Applicant respectfully submits that no new matter has been introduced into the subject application. Specifically, the amendments to the claims and new claims are supported by the

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original specification and drawings, for example, as discussed below in greater detail. The Examiner's rejections are respectfully traversed below.

Prior Art Rejections

Claims 1-3, 7-8, 10-16, 19-20, 30-32, 34, 37-39, 43, and 45-49 are rejected under 35 U.S.C. Section 102(e) as being anticipated by Browning.

The Browning patent was filed on December 04, 2001. Applicant is submitting herewith a partial copy of the technical documentation associated with the present invention illustrating the overall invention design having a date of June 02, 1999. Applicant is also submitting herewith a declaration under 37 CFR 1.131 by the inventors confirming that the invention was conceived at least prior to June 02, 1999 and reduced to practice at least prior to June 14, 2000. Therefore, withdrawal of this rejection on this basis alone is respectfully requested.

In view of the above arguments, Applicant respectfully contends that the art of record, taken alone or in combination, does not disclose all of the features of the present invention as claimed in claims 1-92. As such, Applicant respectfully requests allowance of claims 1-92.

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With respect to the amendments to the claims, and new claims, Applicant provides the following examples of support in the specification. For example, pages 44-45 of the specification recite:

At decision step 612, a determination can be made regarding whether system 450 recognizes each bottle 910. Multiple bottle 910 sizes and shapes can be utilized. For example, vision system 518 can optionally verify that bottles 910 are of the correct diameter and/or overhead shape. If a bottle 910 size and/or shape is not recognized, robot 801 will not pick-up the bottle 910, and the bottle 910 can be discarded at step 610, after which updated bottle 910 position data is provided to robot 801 at step 608. In an embodiment of system 501, bottles 910 that are not recognized (e.g., wrong bottle, wrong size/shape, bottle fallen over) by vision system 518 are driven off the end of the conveyor 701 into bottle return bin 410. An operator can empty bottle return bin 910 and reload the proper bottle (e.g., fallen over bottles) 910 onto conveyor 701.

Page 50 recites:

After bottle 910 is rotated approximately 180°, as shown in FIG. 9f, the contents of bottle 910 can be emptied into a pill accumulation chute 1401a, 1401b. When the bottle is placed upright in gripper assembly 901a, 901b, any

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cotton can be removed with the cutting operation. Cotton can also be removed, for example, by a robot 801 vacuum.

Page 51 recites:

Because some bottles 910 may contain residual glue from the literature that was removed from the bottle 910, a non-stick coating can optionally be added to grippers 908a, 908b to facilitate release of a bottle 910. In addition, a continuous stream or intermittent shot of air can optionally be used in addition to our in lieu of the non-stick coating to "blow" the bottle out of grippers 908a, 908b.

Pages 54-55 recite:

FIG. 14 is an exemplary embodiment of a pill accumulation chute 1401. The contents of bottle 910 (e.g., pills) are emptied into funnel 1402 that directs the pills into bulk-up container 1406. Manifold 1404 connects bulk-up container 1406 to funnel 1402, and can optionally include a vacuum to absorb any pill dust that may emanate from placing the pills in bulk-up container 1406.

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Page 55 recites:

Referring to FIG. 15, a light beam unit (e.g., a Banner A-Gage™ Mini-Array™ unit) 1501 is shown that can be positioned, for example, on opposing sides of accumulation chute 1401 to verify that product did indeed empty out of bottle 910 and onto pill collection chute 1401. Light beam unit 1501 is preferably but optionally integrated with control system 506.

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CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

In addition, each of the combination of limitations recited in the claims includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, Applicants respectfully request withdrawal of the rejection.

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art are combined, the combination of elements of claims, when each is interpreted as a whole, is not disclosed in the Examiner's proposed combination. As the combination of elements in each of the claims is not disclosed, Applicants respectfully request that the Examiner withdraw the rejections.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when

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each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above.

However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would

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understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

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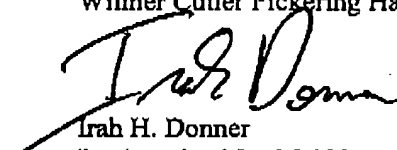
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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